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| 09/753,882      | 01/03/2001  | Mark E. Peters       | RSW920000111US1     | 1389             |

7590 11/14/2005  
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EXAMINER

HUYNH, CONG LAC T

ART UNIT PAPER NUMBER

2178

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/753,882

Applicant(s)

PETERS, MARK E.

Examiner

Cong-Lac Huynh

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2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33,35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33,35 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: amendment filed 9/8/05 to the application filed 1/03/01.
2. Claims 1-32, 34, 36, and 38 are canceled.
3. Claims 33, 35, 37 are pending in the case. Claims 33, 35, and 37 are independent claims.
4. The rejections of claims 1-32 under 35 U.S.C. 103(a) as being unpatentable over Reilly in view of Eldering have been withdrawn in view of the cancellation of claims 1-32.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 33-38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al. (US Pat No. 5,740,549, 4/14/98, filed 6/12/95) in view of Eldering (US Pat No. 6,324,519 B1, 11/27/01, filed 3/12/99).

Regarding independent claim 33, Reilly discloses:

- generating a subscriber list including identifications of a plurality of subscribers for the publication (**col 4, lines 2-7**: the fact that the list of subscribers is provided to the server indicates such a list is generated to be provided to the server; **col**

**16, lines 46-54:** the fact that the server's database includes a catalog which lists all subscribers authorized to receive new items and advertisements from the server indicates that generating a list of subscriber should be performed; also, it is clear that the subscriber list should have the names of the subscribers, which are the identifications of the subscribers)

- providing, to an advertiser, at least a portion of the subscriber list including identifications of a first of the subscribers and a second of the subscribers different from the first subscriber (**col 16, lines 46-54:** subscribers in the list authorized to receive new items and advertisements are provided to the server; it is clear that the subscribers in the list are at least the first and the second subscribers and must have the subscribers' names, which are the identifications of the subscribers; and the information server, which has advertisements (figure 1), is equivalent to an advertiser)
- associating the first advertisement with the first subscriber based on the identification of the first subscriber (**col 15, lines 28-52:** the fact that only news items corresponding to the subscriber's user profile are selected to be provided to users shows associating a selected content with a subscriber; the fact that associating a selected content with a subscriber where each subscriber has a name or an identifier (figure 4) implies that said associating be applied to a first subscriber or a second subscriber with the first or second content depending on the subscriber's identification in each subscriber's profile)

- associating the second advertisement, different from the first advertisement, with the second subscriber based on the identification of the second subscriber (see step associating above)

Reilly does not explicitly disclose:

- generating a first version of the publication including the first advertisement in a prescribed field of the publication for the first subscriber
- generating a second version of the publication including the second advertisement in a prescribed field of the publication for the second subscriber
- integrating content not designated by the advertiser into the first version of the publication and the second version of the publication
- printing the first version and the second version of the publication
- distributing the printed first version of the publication to the first subscriber and the printed second version of the publication to the second subscriber

Eldering discloses:

- generating a first version of publication including the first advertisement for the first subscriber (**col 3, line 65 to col 4, lines 1-16**: the advertisements based on a consumer profile that are inserted into a newspaper and delivered to a consumer are considered as a specific version in a prescribed field of the publication generated specifically for a subscriber; since each subscriber has a different profile, and thus receives different advertisement, it is clear that a first subscriber would have a first version of publication generated including the first advertisement)

- generating a second version of publication including the second advertisement for the second subscriber (**col 3, line 65 to col 4, lines 1-16**: the advertisements based on a consumer profile that are inserted into a newspaper and delivered to a consumer are considered as a specific version in a prescribed field of the publication generated specifically for a subscriber; since each subscriber has a different profile, and thus receives different advertisement, it is clear that a second subscriber would have a second version of publication generated including the second advertisement)
- integrating content not designated by the advertiser into the first version of the publication and the second version of the publication (**col 11, line 63 to col 12, line 8**: integrating the magazines or newspapers, which are content not designated by the content provider with the advertisement into the publication)
- printing the first version and the second version of the publication (**col 11, line 63 to col 12, line 8**: printing the advertisement and the magazine or the newspaper as a version of publication)
- distributing the printed first version of the publication to the first subscriber and the printed second version of the publication to the second subscriber (**col 11, lines 63 to col 12, line 8**: *delivering the printed ad inserted into the periodical to the subscriber*)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Eldering into Reilly since Eldering discloses generating a version of publication including the selected content, which is an advertisement for

delivering to a subscriber thus motivating to incorporate the advertisement provided to a subscriber based on the subscriber's profile to any newspaper or magazine delivered to a subscriber. As such, subscribers or consumers would receive more targeted advertisements that match their lifestyle and interests via the magazine and newspaper, and the selling companies would sell more products thanks to the advertisement's method.

Regarding the limitation "receiving an identifier of a first advertisement based on buying preferences of the first subscribers and an identifier of a second advertisement based on buying preferences of the second subscribers from the advertiser", Reilly discloses receiving an identifier of a first advertisement *based on preferences* of the first subscriber and a second advertisement *based on preferences* of the second subscriber from the advertiser (col 5, line 61 to col 6, line 10: displaying statistics indicating how many times *each advertisement* has been displayed on subscribers' computers implies that a designation of said advertisement, *not the advertisement itself*, is received at a subscriber's computer, from the information server, which is equivalent to an advertiser; also, an indication of each advertisement a user has interacted with such as clicking on the advertisement to connect to the advertiser's World Wide Web page implies that said advertisement *must have a name to be recognized, where the name is an identifier of the advertisement*).

Reilly does not disclose explicitly that the preferences are the buying preferences.

Eldering discloses that providing the advertisements to a subscriber is based on the subscriber's *product preferences* determined by the *purchase records* of the subscriber

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(col 4, lines 11-54, col 8, lines 15-33, col 10, lines 16-28: the specific purchase records and the product preference characteristics show the buying preferences of the subscriber).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Eldering into Reilly since Eldering discloses providing advertisements to a subscriber based on the buying preferences thus motivating to incorporate to Reilly the buying preferences as a specific type of preferences for determining the subscriber's interest to provide the advertisement of interest to a subscriber.

Claims 35 and 37 are for a system and a program product of method claims 33-34, and are rejected under the same rationale.

### ***Response to Arguments***

7. Applicant's arguments filed 9/8/05 have been fully considered but they are not persuasive.

Regarding independent claim 33, Applicants argue that Reilly and Eldering do not disclose or suggest receiving an identifier of an advertisement, in lieu of the advertisement content itself, from the advertiser (Remarks, page 22).

Examiner agrees the Reilly and Eldering does not explicitly use the word "identifier" of an advertisement.



However, Reilly does disclose an indication of each advertisement that a user has interacted with such as *clicking on the advertisement* to connect to the advertiser's World Wide Web page (col 6, lines 1-10). This implies that said advertisement has a name to be recognized, where the name is an identifier of the advertisement.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Logan et al. (US Pat No 6,199,076).

Landau et al. (US Pat App No 2002/0082919 A1).

Khoo et al. (US Pat App No 2004/0193488 A1).

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh  
Primary Examiner  
Art Unit 2178  
11/07/05